

REMARKS

In response to the Restriction Requirement of July 5, 2005, Applicant would like to propose new groupings of species for the Examiner's consideration. Should this new grouping of species be acceptable to the Examiner, Applicant would like to elect Species D and indicate that the claims which read upon Species D are: 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 34, 36, 37, 38, 39, 40, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, and 73.

The Proposed new grouping of species is as follows:

- Species A: Switch Circuit with Charge-based current mirror coupled to a control node
- Species B: Switch Circuit with single pFET coupled to a control node
- Species C: Switch Circuit with high-voltage RS latch circuit coupled to a control node
- Species D: Switch Circuit with Pull-up Circuit coupled to a control node
- Species E: Switch Circuit with three nFETs coupled to a control node
- Species F: Switch Circuit having pFETS with cross-coupled gates and drains with sources coupled to a high-voltage supply node.

Should, however, the Patent Office refuse to accept the new groupings and maintain the previous restriction requirement, Applicant hereby provisionally elects Species 4 of the original restriction, which reads upon 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 34, 36, 37, 38, 39, 40, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, and 73, and traverses the restriction requirement.

Applicant hereby traverses the restriction requirement on the basis that the identification of species based upon figures unduly limits the scope of protection of any of the elected species. Should any of the current claims, or any claims added later in prosecution, be deemed by the Patent Office or a court to be read under 35 U.S.C. 112, paragraph 6, then those claims would be "construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." However, election of a species based on a figure or figures, where all other species are also identified by a figure or figures, has the effect of "removing" from the specification all figures not identified as being a part of the elected species. In the present case, under the current restriction requirement, if Applicant elected Species 1, which is based on Figure 3, then Figures 4, 5, 6, 13, 14A-14B, 15, 16, 17, and 18 would all be essentially deleted from the application, and thus unavailable as "corresponding structure, material, or acts". Thus, the only structure available for interpretation of the claims under 35 U.S.C. 112, paragraph 6 would be Figure 3.

To make matters worse, assume a claim interpreted under 35 U.S.C. 112, paragraph 6 is allowed after Applicant elected Species 1 under the current restriction requirement. As described above, such a claim would be limited to Figure 3 only. Applicant would then be barred from obtaining similar protection on any of the other species because a duplicate of the allowed claim in a divisional application would be rejected under statutory double patenting (35 U.S.C. 101), despite the fact that due to the claims being interpreted using different figures the claim scope would be different.

Therefore, should applicant elect a species under the current restriction requirement, Applicant would be improperly forced to give up future versions of the claims under 35 U.S.C. 112, paragraph 6 to any of the remaining species.

As such, Applicant respectfully submits that the restriction request is improper. Applicant believes that this problem does not arise if the restriction requirement is made based on anything other than the figures, for example, basing the restriction requirement on a description of the proposed species, or based on the claims.

Additionally, Applicant respectfully submits that the restriction is improper because the species identified, and hence their corresponding claims, are not mutually exclusive. Specifically, one or more of the figures utilized as a basis for the restriction requirement is/are not mutually exclusive from one or more of the other figures utilized as a basis for the restriction requirement. Thus, any claims chosen for the identified species would violate M.P.E.P 806.04(f).

Furthermore, Applicant respectfully submits that the restriction is improper because it is unclear why the limitations in the claims are considered to restrict the claims to a particular disclosed species. M.P.E.P. 814 requires that "the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be maintained if necessary to make the requirement clear." Applicant respectfully maintains that the requirement is unclear for two reasons. First, as stated above, it is not clear how claims corresponding to the figures would be mutually exclusive. Applicant is unable to determine, for example, how claims directed towards species 6 (described as FIG. 15) would be

mutually exclusive from claims directed towards species 7 (described as FIGS. 16-17), as the claims directed toward species 6 would also be directed toward species 7 as best as Applicant can determine. Second, M.P.E.P. 809.02(a) requires that the Patent Office "[i]dentify generic claims or indicate that no generic claims are present". The restriction requirement states that "Currently, no generic". Applicant assumes that the rest of the sentence was supposed to read "are present", yet this is contradictory with the indicated species. Namely, claim 1 appears to be generic to all species identified in the restriction requirement. Applicant cannot reconcile the Patent Office's position that there are no generic claims with the selection of the figures for the species, and thus Applicant is unclear as to the basis for the selection of the various species.

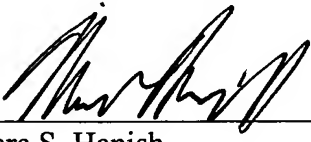
Should the Examiner elect to maintain the present restriction requirement or otherwise reject this application finally or non-finally for Applicants' refusal to elect a figure for prosecution, then this paper is to be treated as a petition to the Commissioner under 37 C.F.R. §1.183 to waive such rules as necessary, in the interests of justice, to prevent an unnecessary extinguishment of applicants' rights as detailed above. Any fees associated with the petition may be charged to our deposit account as set forth below.

Applicant reserves the right to pursue the claims of any other species in a divisional application.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account 50-1698.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: 8/2/05



Marc S. Hanish
Reg. No. 42,626

THELEN REID & PRIEST LLP
PO Box 640640
San Jose, CA 95164-0640
Telephone: (408) 292-5800
Facsimile: (408) 287-8040